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EXAMINER

KASZTEJNA, MATTHEW JOHN

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte GUY E. HORNE JR., and JAMES P. BARRY

Appeal 2010-000500
Application 10/766,295
Technology Center 3700

Oral Hearing Held: October 25, 2011

Before STEVEN D. A. McCARTHY, ROBERT A. CLARKE, and CHARLES N. GREENHUT, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

BENJAMIN C. WHITE, ESQUIRE
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The above-entitled matter came on for hearing on Tuesday, October 25, 2011, commencing at 1:52 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Courville, a Notary Public.

PROCEEDINGS

THE USHER: Calendar No. 69, Appeal No. 2010-000500, Mr. White.

JUDGE McCARTHY: Ready? Good afternoon, Mr. White. Thank you for coming in. We have had the opportunity to read the briefs and are familiar with the technology. You have 20 minutes, as soon as you're ready.

MR. WHITE: Thank you, good afternoon. You have the briefs. What I'm going to do is give you a few comments to clarify and add to the arguments in those briefs.

The claims all require a tubular member in an endoscope that's jacketed by four specific layers: a barrier layer jacketing the tubular member itself, a braided layer jacketing the barrier layer, a laminating layer over the braided layer, and a wear layer over the laminating layer.

Now, the primary reference used by the Examiner is Krauter, and Krauter discloses an endoscope but does not disclose a tubular member as claimed. Instead, it teaches use of a Mono-Coil 21. Krauter also does not disclose the four claimed layers jacketing the Mono-Coil. Krauter teaches three layers over the Mono-Coil, first a jacket 22, and this is shown pretty clearly in Figure 2. First, there's a jacketing layer 22 that's over the Mono-Coil, 21. A braid layer 23 is over that, and finally, a coating layer 24.

Now, the primary purpose of the disclosure of Krauter is to limit leakage currents from the endoscope by isolating the braid layer 23, using the jacket 22 and the coating layer 24. These layers on both sides cause it to float, as the reference describes. And by doing that, it's isolated from the coil at both ends.

The Examiner argued that it would have been obvious, based on the teaching of Abe reference, to include a laminated layer in the device of Krauter between the jacket 22 and the braid layer 22. Now, Appellant submits that the Examiner is ignoring critical teachings of the Abe reference that would not have led one of skill in the art to the claimed invention. In fact, this modification would not have been made.

Now, Abe discloses the use of an inner layer 32 over a braided member 22 and a helical coil 21. The braided member 22 and the helical coil 21 form what the reference calls the core body 2 of the device. The inner layer 32 is part of an outer cover, which is 3, and this is all shown in Figure 5 of this reference.

Now, Abe specifically teaches that the inner layer 32 is formed so that parts of it protrude through the braided member 22 and into the gaps of the coil 21. This is shown in Figure 5. If you look, the protrusions are designated with number 31. The purpose of this teaching of Abe is to achieve increased adhesion between the outer cover 3 and the core body 2 which, according to Abe, results in better resilience and durability of the endoscope. These benefits, that is, better resiliency and durability, are precisely what the Examiner argued would have been the motivation for one of skill in the art to modify Krauter. But these benefits of incorporating the inner layer 32 into the endoscope of Krauter would not be obtainable

1 without also removing the jacket layer 22 of Krauter. Otherwise, the inner
2 layer 32 of Abe could not have penetrated the gaps in the Mono-Coil 21 of
3 Krauter. It would only have contacted the jacket 22.

4 This would not have provided the benefit taught by Abe of increased
5 adhesion between the cover and the core of the endoscope. But if one were
6 to remove the jacketing layer 22 of Krauter, so as to take advantage of the
7 full teaching of Abe, the result would not have been the claimed invention
8 because the claims recite a barrier layer that is between the braided layer and
9 the tubular member, which in the case of Krauter is the Mono-Coil 21.

10 So if one of ordinary skill in the art had been motivated to increase the
11 resiliency and durability of the endoscope of Krauter based on the teaching
12 of Abe, that person would have modified the endoscope of Krauter away
13 from the claimed invention, that is, to remove the jacket layer 22. So it's the
14 Appellant's position that one of ordinary skill in the art would not have
15 combined the teachings of Krauter and Abe as the Examiner's argued
16 because doing so -- I'm sorry, because this modification would not have
17 resulted in the claimed invention. And for that reason, the Appellant
18 respectfully requests reversal of the rejections.

19 Now, I'm happy to answer any questions at any time. But another
20 point would be that it's not fair to conclude that one of skill in the art would
21 have taken only part of the teaching of Abe. That is, one of skill in the art
22 would not have added the inner layer 32 without also causing it to penetrate
23 into the gaps of the coil. The penetration by the inner layer 32 into the core
24 body is an important teaching of Abe to accomplish the goals of resiliency
25 and durability. The teaching of a reference as a whole needs to be

26

1 considered, and for that reason we think that further supports the Appellant's
2 position.

3 JUDGE McCARTHY: Sorry. Once again, we apologize for the
4 delay.

5 MR. WHITE: That's no problem

6 JUDGE CLARKE: I guess I'll start in. The primary reference to
7 Krauter, it has this layer 24 which serves as a protective layer, but it also
8 adheres to the braided layer. Is that correct?

9 MR. WHITE: I believe that's correct, yes.

10 JUDGE CLARKE: And Abe has a disclosure to adhere this layer 32
11 to a braided layer and also to an underlying layer through holes in the
12 braided layer. Is that --

13 MR. WHITE: I believe that's correct. The Abe reference, the inner
14 layer 32 will adhere to the braided layer in Abe, as well as --

15 JUDGE CLARKE: And then, through the braided layer into the
16 underlying layer?

17 MR. WHITE: Correct, through penetrating the gaps in the coil.

18 JUDGE CLARKE: Okay.

19 JUDGE McCARTHY: Counsel, we have the two layers, I believe
20 they're 33 and 34, on Figure 5?

21 MR. WHITE: Yes, I see them.

22 JUDGE MCCARTHY: If I understand correctly, those two layers,
23 they are to provide a different set of properties which are advantageous in
24 the endoscope?

25 MR. WHITE: I believe that's likely correct.

26

1 JUDGE McCARTHY: Why wouldn't it be obvious to have split the
2 outer layer of the endoscope in Krauter into two layers, each having similar
3 advantages?

4 MR. WHITE: Well, one reason, off the top of my head, would be
5 increased cost to manufacture the device, increased bulk to add another
6 layer. I'm not aware of a suggestion in Krauter or Abe to do so. But it's well
7 known in the art that endoscopes are best implemented with very small
8 profiles to limit the effects on patients. So simply adding layers on top of
9 layer in Krauter would not necessarily have been obvious to one skilled in
10 the art.

11 JUDGE McCARTHY: And would it have been deleterious because it
12 would have increased the profile of the endoscope?

13 MR. WHITE: That's one possibility from the standpoint of one of
14 skill in the art at the time.

15 JUDGE CLARKE: I think in column 6 of Abe, there's a lengthy
16 discussion of the various properties that layer 32 and 34 should have, which
17 are physical properties. It's lines 44 through 55 in column 10.

18 MR. WHITE: I see that.

19 JUDGE CLARKE: So if one were to desire one of these properties, it
20 would be a trade-off, naturally, in any manufacturing process to have
21 additional cost. Is there some evidence of the additional size being a
22 negative?

23 MR. WHITE: Well, I'm not aware of evidence off the top of my head
24 specifically with respect to the size of the endoscope. But this portion of
25 Abe describes the excellent adhesion between the coating layer 231 and the
26 outer cover 3.

1 That adhesion is what results, according to Abe, in the increased
2 resiliency of the device, less separation between the layers, which our
3 reading of Abe is accomplished using the protrusions to a significant extent.
4 So without use of those protrusions, I think the motivation to include that
5 into Krauter would not be there.

6 JUDGE CLARKE: And the outer layer of Krauter does, in fact,
7 adhere to the braided layer in Krauter as one of the functions, one of the
8 functions of the outer layer -- was it 24?

9 MR. WHITE: Yes, I believe my understanding is that the outer layer
10 24 in Krauter will adhere to the braided layer.

11 JUDGE CLARKE: Right.

12 MR. WHITE: But I'm unaware of any disclosure of adherence
13 between that layer and any layer beneath the braided layer.

14 JUDGE CLARKE: Right.

15 JUDGE McCARTHY: Counsel, if you have anymore to say to us or
16 if you wish to conclude, please go ahead.

17 MR. WHITE: Well, I think I am set. The Appellant respectfully
18 requests for reversal. The obviousness rejections are not well supported.
19 And I thank you for your time.

20 JUDGE McCARTHY: Thank you. We are off the record, then.
21 (Whereupon, the proceedings, at 2:05 p.m., were concluded.)